

### INTERVIEW SUMMARY

Applicant would like to thank the Examiner for the telephone interview initiated by the Applicant on September 24, 2009, which interview included Jennifer L. Hornberger, Examiner, Christopher L. Johnson (#46,809) and Bradley P. Cardon (#63,021), Attorneys for Applicant, and Dr. Earl C. Downey, Inventor.

During the interview Applicant and Examiner discussed the distinguishing features of the invention as compared to the Freeman reference, as well as proposed amendments to further define the shape of the handle of the present invention to distinguish over the prior art. Possible amendments that were talked about during the interview included defining the handle as having a grip portion and an upper portion, a handle aperture formed into a sidewall of the upper portion to provide access to the finger receiving portion of a finger actuator disposed within the handle, and defining the finger receiving portion of the finger actuator as an actuating ring within the aperture of the handle. Applicant and Examiner also conferred about the benefit of providing a 37 CFR 1.132 declaration by one of skill in the art directed towards the ergonomic position of a hand grasping the handle of the present invention.

No other pertinent matters were discussed.

### REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed May 27, 2009, in which claims 1-20 were rejected.

Claims 1-21 remain in the application. Claims 1-20 were originally presented. Applicant proposes to amend claims 1, 12 and 19, and to add new claim 21, and respectfully requests reconsideration of the application as amended herein. The subject matter of the amendments is found in the original specification and drawings, and no new matter has been added.

### ***Claim Rejections -- 35 U.S.C. § 102***

1. Anticipation rejection based on United States Patent No. 6,074,408 to Freeman.

Claims 1, 2, 5, 9-12, and 15-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,074,408 to Freeman (hereinafter referred to as

“Freeman”). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted under 35 U.S.C. § 102(b) that claim 1 includes subject matter that is allowable over Freeman, since this reference fails to disclose each and every element as set forth in the independent claim. More specifically, Freeman fails to disclose a surgical device having an ergonomic handle having a grip portion and an upper portion with **a handle aperture formed in a sidewall** and accessible by a single finger of a user, and a finger actuator having **an actuating finger receiving portion within and accessible through the handle aperture**, as recited in the claim. Freeman also fails to disclose **maintaining a hand of the user** about the ergonomic handle **in a position consistent with a functional position** of the hand, as also recited in claim 1.

In the Interview Summary issued by the Examiner and mailed on October 16, 2009, the Examiner commented that “the limitation of an actuating ring within the aperture of the handle” would distinguish the instant invention from the prior art of Freeman. Applicant has substantially adopted the suggestion provided by the Examiner, but rather than reciting a “ring,” Applicant has recited a “finger receiving portion” within and accessible through the handle aperture. This difference in language functions to capture the embodiments as set forth in the application (see FIGS. 1 and 4 ), while still falling within the reasons set forth by the Examiner for distinguishing over Freeman.

Freeman discloses the actuator handle 16 of an endoscope which includes a handle body 26 having a thumb ring 28 formed on the end thereof, and a two ring finger slide member 70 that slides relative to the handle body. (see Freeman; FIGS. 1 and 6; Col. 7, lines 37-43. As can be seen, the ring apertures of the finger slide member are not accessible through the thumb ring, as the two structures are spaced widely apart in all positions. Therefore, Applicant respectfully submits that Freeman fails to disclose an actuating finger receiving portion within and accessible through a handle aperture, as recited in claim 1.

Applicant further submits that Freeman also fails to disclose maintaining a hand of the user in a position consistent with a functional position of the hand when operating the actuator handle 16. Submitted with this response is a declaration under 37 CFR 1.132 of Dr. W. Bradford Rockwell, an accomplished expert in the field of hand medicine. Dr. Rockwell is a board-certified plastic surgeon in the field of hand surgery who completed a hand surgery fellowship at the University of Rochester in Rochester, NY. Since then Dr. Rockwell has practiced medicine for seventeen years and is the current Chief of the Division of Plastic Surgery at the University of Utah Health Sciences Center. (See the attached curriculum vita of Dr. Rockwell.)

Beginning with paragraph 7 of his declaration, Dr. Rockwell states that a “functional position” used to describe the position of a user’s hand when grasping a handle has recognizable meaning as a particular hand position that is taught in the medical arts. He further declares that in his opinion, the ergonomic handle of the Downey surgical instrument comprises structure permitting operation of the instrument with the hand of the user in a position consistent with the functional position, as recited in claim 1. Dr. Rockwell also goes on to state that the medical instrument of Freeman, as illustrated in FIG. 5, precludes the placement of the hand of the user in a position consistent with the functional position during operation.

Based on this declaration and the above discussion, Applicant respectfully submits that Freeman fails to disclose each and every element of independent claim 1, which is allowable. Applicant further submits that claims 2, 5 and 9-11 are also allowable, as depending either directly or indirectly from an allowable base claim.

With regard to independent claim 12, it is respectfully submitted that claim 12 also includes subject matter that is allowable over Freeman, since the reference fails to disclose each and every element as set forth in the independent claim. More specifically, and for the reasons cited above, Freeman fails to disclose a surgical system having an ergonomic handle having a grip portion and an upper portion with **a handle aperture formed in a sidewall** and accessible by a single finger of a user, and a finger actuator having **an actuating finger receiving portion within and accessible through the handle aperture**, as recited in claim 12. Consequently, Applicant respectfully submits that Freeman fails to disclose each and every element recited in independent claim 12, which is therefore allowable. Applicant further submits that claims 15-18 are allowable as depending either directly or indirectly from allowable base claim.

With regard to independent claim 19, it is respectfully submitted that claim 19 also includes subject matter that is allowable over Freeman, since the reference fails to disclose each and every element as set forth in the independent claim. More specifically, and for the reasons cited above, Freeman fails to disclose a method of manipulating a surgical instrument that includes the step of inserting a single finger into **a finger receiving portion of a finger actuator located within and accessible through a handle aperture** of an ergonomic handle of the surgical instrument, as recited in claim 19. Freeman also fails to disclose moving a single finger of the hand to actuate the finger actuator while continually **maintaining the hand of the user** about the ergonomic handle in **a position consistent with a functional position of the hand**, as also recited in claim 19. Consequently, Applicant respectfully submits that Freeman fails to disclose each and every element recited in independent claim 19, which is therefore allowable.

Based on the foregoing, Applicant respectfully submits that Freeman does not anticipate any of the claims of the present invention. As such, Applicant respectfully requests that the rejections under 35 U.S.C. § 102 be withdrawn from consideration.

#### ***Claim Rejections - 35 U.S.C. § 103***

2. Obviousness rejection based on Freeman in view of United States Patent No. 4,043,323 to Komiya.

Claims 3 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of United States Patent No. 4,043,323 to Komiya (hereinafter referred to as “Komiya”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claims 3 and 13 are allowable as depending from allowable independent claims 1 and 12, respectfully, and Applicant urges the Examiner to withdraw the rejection.

3. Obviousness rejection based on Freeman in view of United States Patent No. 5,258,006 to Rydell et al.

Claims 4, 14, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of United States Patent No. 5,258,006 to Rydell et al. (hereinafter referred to as “Rydell”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claims 4, 14 and 20 are allowable as depending from allowable independent claims 1, 12

and 19, respectfully, and Applicant urges the Examiner to withdraw the rejection.

4. Obviousness rejection based on Freeman in view of United States Patent No. 4,226,239 to Polk et al.

Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of United States Patent No. 4,226,239 to Polk et al. (hereinafter referred to as “Polk”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claims 6 and 8 are allowable as depending from allowable independent claim 1, as discussed hereinabove, and Applicant urges the Examiner to withdraw the rejection.

5. Obviousness rejection based on Freeman in view of Polk and further in view of United States Patent No. 6,077,286 to Cuschieri et al.

Claims 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman in view of Polk as applied to claim 6, and further in view of United States Patent No. 6,077,286 to Cuschieri et al. (hereinafter referred to as “Cuschieri”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 7 is allowable as depending from allowable independent claim 1, as discussed hereinabove, and Applicant urges the Examiner to withdraw the rejection.

Based on the foregoing, Applicant submits that the prior art does not render the claims of the present invention obvious. As such, Applicant respectfully requests that the claims of the application be reconsidered and that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the proposed claims are neither anticipated nor rendered obvious by the prior art references cited by the Examiner. As such, Applicant believes that the application is now in a condition for allowance, and action to that end is respectfully requested.

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 27th day of October, 2009.

Respectfully submitted,

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